

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

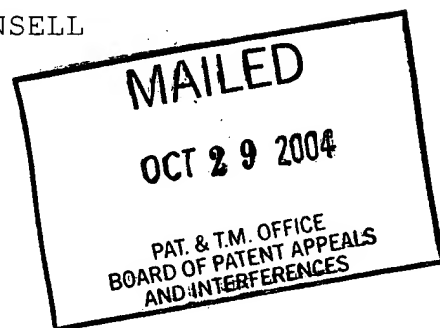
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIP R. WISER,
ANDREW R. CHERENSON, STEVEN T. ANSELL
and
SUSAN A. CANNON

Appeal No. 2004-1347
Application 09/289,513

ON BRIEF



Before JERRY SMITH, FLEMING, and RUGGIERO, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-49, which constitute all the claims in the application.

The disclosed invention pertains to a method for conducting electronic commerce through a computer network.

Representative claim 1 is reproduced as follows:

1. A method for conducting electronic commerce through a computer network, the method comprising:

receiving, in a merchant computer system of the computer network, a purchase request for a digital product;

receiving payment data in the merchant computer system wherein the payment data specifies remuneration for the digital product;

sending a request for reservation of the digital product to a content manager computer system which can be different from the merchant computer system and which is coupled to the merchant computer system through the computer network;

receiving, in the content manager computer system, a delivery request signal from the merchant computer system wherein the delivery request signal requests delivery of the digital product to a client computer system through the computer network;

sending transaction identification data to the client computer system wherein the transaction identification data identifies the digital product and represents remuneration in accordance with the payment data;

receiving, in a delivery computer system of the computer network, the transaction identification data from the client computer system;

determining within the delivery computer system, in accordance with the transaction identification data, the digital product; and

sending, from the delivery computer system, the digital product to the client computer system.

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The examiner relies on the following references:

Payne et al. (Payne)	5,715,314	Feb. 03, 1998
Stefik et al. (Stefik)	6,236,971	May 22, 2001
		(filed Nov. 10, 1997)

Claims 1-3, 10-26 and 39-49 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Payne. Claims 4-9 and 27-38 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the examiner offers Payne in view of Stefik.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION.

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon supports each of the examiner's rejections. Accordingly, we affirm.

We consider first the rejection of claims 1-3, 10-26 and 39-49 as being anticipated by the disclosure of Payne. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he reads the claimed invention on the disclosure of Payne [answer, pages 3-9]. With respect to independent claim 1, appellants argue that Payne fails to disclose a merchant computer system that both receives a purchase request for a digital product and sends to the content manager computer system a request that the digital product be

delivered to a client. Specifically, appellants argue that Payne is devoid of any teaching that a first computer system that receives a purchase request and payment, and a second computer system that requests delivery to the buyer, can communicate with each other directly. Thus, appellants argue that claim 1 requires the request to deliver a product be sent from the computer that receives payment to the computer that causes the purchase to be fulfilled, and that Payne has no such direct communication. Appellants note that the direct communication of the claimed invention provides an added level of security to their system. Appellants argue that the examiner's position that the buyer's computer in Payne is merely a conduit in sending data from one place to another is incorrect. Appellants argue that the buyer's computer in Payne changes the data before it is sent to the merchant computer [brief, pages 5-11].

The examiner responds by explaining how Payne does teach a single computer system that both receives a purchaser's payment data for a product and sends a request to another system directing that the purchaser receive the product. The examiner disagrees with appellants' assertion that the buyer's computer in

Payne processes the data in some way before it is sent to the merchant computer, but the examiner notes that in any case, the merchant computer must receive the same information that was sent by the payment computer in order to function properly. Finally, the examiner points to a section of Payne which describes the process of communicating the access message between the payment computer and the merchant computer without any mention of the buyer computer [answer, pages 12-15].

We will sustain the examiner's rejection of argued claim 1 and of claims 2-8, 10-12, 14-22 and 24-38 which are grouped therewith [brief, page 5] for essentially the reasons argued by the examiner in the answer. We also note that the thrust of appellants' arguments is that there is no direct connection between merchant computer 14 and payment computer 16 of Payne. Appellants' arguments use the term "directly" on page 6 of the brief and the terms "direct" or "directly" three times on page 7. There is no recitation in claim 1, however, that two computer systems must have a direct communication therebetween. We agree with the examiner that the fact that data which is communicated between the payment computer and the

merchant computer in Payne is routed through the buyer computer fails to distinguish Payne from the claimed invention. We also agree with the examiner that the important data for the transaction in Payne is not modified by its routing through the buyer computer. Therefore, we are not persuaded by any of appellants' arguments with respect to the patentability of claim 1.

With respect to independent claim 39 and claims 40, 41 and 43-49 which are grouped therewith [brief, page 5], appellants argue that there is no teaching in Payne that the payment and merchant computers communicate directly, or that they are otherwise connected to each other through a computer network [brief, pages 11-12].

The examiner responds that Figure 1 of Payne and Payne's disclosure demonstrate that the buyer, merchant, payment and creation computers are all interconnected by a computer network 10 such as the Internet [answer, page 15].

We will sustain the examiner's rejection of argued claim 39 and of claims 40, 41, and 43-49 which are grouped therewith for the reasons indicated above and the reasons argued by the

examiner in the answer. The various computers in Payne are clearly connected through a computer network 10.

With respect to separately argued claim 13 and claim 42 which stands or falls with claim 13, appellants argue that Payne fails to disclose the claimed payment authority [brief, page 13]. The examiner responds that the computers disclosed by Payne meet the claimed payment authority [answer, page 16].

We will sustain the examiner's rejection of claims 13 and 42. We agree with the examiner that the computers in Payne can form the claimed payment authority.

With respect to separately argued claim 23, appellants rely on the same arguments discussed above with respect to claim 1. Therefore, we sustain the examiner's rejection of claim 23 for the reasons discussed above with respect to claim 1.

We now consider the rejection of claims 4-9 and 27-38 as being unpatentable over the teachings of Payne and Stefik. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner

is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the

evidence as a whole and the relative persuasiveness of the arguments. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

The examiner has indicated how he finds the claimed invention to be obvious over the teachings of Payne and Stefik [answer, pages 10-12]. The only claim subject to this rejection which is argued by appellants is claim 9. Therefore, we will consider claim 9 as the representative claim for all claims subject to this rejection. With respect to claim 9, appellants argue that neither Payne nor Stefik teaches the discarding of an encryption key as claimed [brief, page 13]. The examiner responds that Stefik teaches the use of a "one-time" key which is discarded to a restoration file after use. The examiner finds that a key which is used only one time is essentially a key which

is discarded after that one use. The examiner notes that the teaching in Stefik of permanently storing the key in a location after it has been used once suggests the claimed steps of discarding the encryption key as recited in claim 9 [answer, pages 15-16].

We will sustain the examiner's rejection of claims 4-9 and 27-38 for the reasons argued by the examiner in the answer. Appellants have offered no specific rebuttal to the examiner's finding that the "one-time" encryption key of Stefik constitutes a discarded key as claimed. Therefore, appellants have not persuaded us that the examiner's rejection is in error.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-49 is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

Jerry Smith

JERRY SMITH
Administrative Patent Judge

Michael R. Fleming

MICHAEL R. FLEMING
Administrative Patent Judge

Joseph F. Ruggiero

JOSEPH F. RUGGIERO
Administrative Patent Judge

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JS:psb

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